

### **REMARKS**

In the August 6, 2003 Office Action and the October 21, 2003 Advisory Action, the Examiner rejected claims 1-16 and 19-46 pending in the application. Upon entry of the foregoing amendments, Applicants amend claims 1, 7, 15, 23, and 33 and adds new claims 47-50. Support for the amended claims and the new claims may be found in the originally filed specification, and thus, no new matter is added by this amendment. Upon entry of the foregoing amendments, claims 1-16 and 19-50 (5 independent claims; 48 total claims) remain pending in the application. Applicants thank Examiner for removing the Noblett, Jr. (U.S. Patent No. 5,432,326) and Collins (U.S. Patent Application Publication No. U.S. 2002/0007362) references as grounds for rejections of the current claims. Applicants request reconsideration in view of the above amendments and the following remarks.

### **35 U.S.C. §112**

Claims 1-16 and 19-46 stand rejected under 35 U.S.C. §112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." In particular, the Examiner stated "the inventive concept such as '*pre-existing charge*' described in claims 1, 7, 15, 23 and 33 are not disclosed in the specification." Applicants respectfully traverse this rejection. However, in order to expedite prosecution, in the most recent response, Applicants have amended claims 1, 7, 15, 23, and 33 to delete the phrase "pre-existing charge". As discussed with the Examiner during the telephone interview of October 27, 2003, claims 1-16 and 19-46 are now in conformance with 35 U.S.C. §112, first paragraph, and Applicants respectfully request withdrawal of the rejection of claims 1-16 and 19-39 under 35 U.S.C. §112, first paragraph.

### **35 U.S.C. § 102**

Claims 1-7, 9-17, and 19-46 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rosen, U.S. Patent No. 6,336,095, issued January 1, 2002 (hereinafter

"Rosen"). Applicants respectfully traverse this rejection and provide the following arguments in support.

In general, Rosen discloses a limited system for open electronic commerce between a customer and a merchant, whereby a customer trusted agent securely communicates with a first money module, and a merchant trusted agent securely communicates with a second money module. The merchant trusted agent transfers electronic merchandise to the customer trusted agent, and the first money module transfers electronic money to the second money module. The "trusted agents" are "a combination of hardware and software components." Rosen further provides that "trusted agents" are "tamper-proof and contain[s] secure protocols which cooperate with a money module 6 to synchronize secure payment to deliver." The trusted agents are surrogate actors for an entity who wants to transact remotely (electronically) in a secure way. The trusted agents are "under control of transaction protocols and behave in a way calculated to resolve the transaction to the satisfaction of both parties." Most notably, the trusted agents exchange **electronic merchandise** and payment. (column 4, lines 9-38).

In particular, if a customer is dissatisfied with a purchase, Rosen provides for **remote** resolution of the dispute between the **customer** and **merchant**. (see Column 28, line 42 - column 30, line 47). During such a dispute, Rosen provides that the trusted agents can act as surrogates for the customer and merchant. First, the customer can connect to the merchant and enter into a dispute dialogue (col. 28, lines 45-48). During the dispute dialog, transaction logs are displayed to facilitate the identification of the disputed transaction. In addition, the customer can enter a description of the problem. (see Figure 30A, col. 28, lines 50-55 and col. 29, lines 5-29) However, Rosen does not provide for displaying a pre-defined set of a plurality of available dispute handling forms having pre-defined content. Instead, Rosen displays a transaction log to facilitate the "choice" of the transaction that is to be disputed (see steps 1056 and 1060 in Figure 30A) and Rosen allows the customer/owner to describe the problem (see step 1060 in Figure 30A) . The transaction "choice" and the description of problem are sent between the customer and merchant, and/or their trusted agents, as the "dispute information" (see Figures 30A-30E, col. 29, lines 15-19).

If the customer is not satisfied with the result of the dispute interaction with the merchant, the customer can take his complaint to the "Trusted Agency" (col. 28, lines 52-54). The dispute and accompanying documentation can then be presented to a trusted server on the Trusted Agency Network.

In contrast to Rosen, the presently claimed invention provides for a significantly different system and method that **facilitates "communication** between an **Issuer** and an **Acquirer** in the context of resolving a post-transactional dispute" between the Issuer and the Acquirer. An Acquirer is an entity that markets, installs, and supports POS transaction card acceptance at service establishments, and typically negotiates a contract with the service establishment to accept certain brands of cards. An Issuer is typically a bank or other financial institution that is typically operating under regulations of a card issuing association or entity and which issues cards to cardmembers under a cardmember agreement for a cardmember account. Thus, an Issuer and Acquirer are clearly not equivalent to a customer or merchant as provided by Rosen. Furthermore, the presently claimed invention does not provide for a system or method that includes trusted agents, electronic merchandise, or that provides for participation by a customer or merchant in the dispute resolution. For example, when a post-transaction dispute arises between an Issuer and an Acquirer, the presently claimed invention provides for a system and method that displays, to the Issuer, a pre-defined set of available forms that are available **only** to the Issuer. The Issuer selects one of the available forms and completes the selected form. The Issuer then sends the form to the Acquirer who views the form. The Acquirer then selects a form from a display of a pre-defined set of forms that are available **only** to the Acquirer and also completes the selected form. This process may be repeated for a number of forms.

Rosen fails to teach, suggest or disclose such a system. In particular, Rosen fails to teach, suggest or disclose "facilitating communication between an Issuer and an Acquirer in the context of resolving a dispute" as claimed by Applicants, because it is not the intention of Rosen to resolve disputes between an Issuer and an Acquirer. Rather, Rosen teaches resolving disputes between a customer and merchant, including the examination and/or return of electronic merchandise, and the system taught by Rosen could not be used by Issuers and Acquirers. For example, Rosen provides for

the return of electronic merchandise (Figures 30A-30E, column 28, line 42 - column 30, line 47), and an Issuer or Acquirer would not have access to the electronic merchandise.

Applicants' amended independent claim 1 (and amended independent claims 7, 15, 23 and 33) recites a system "for **facilitating communication between an Issuer and an Acquirer** in the context of resolving a post-transactional dispute, wherein **the dispute is between the Issuer and the Acquirer** and the dispute is related to an executed credit transaction between a cardmember and a service establishment." (emphasis added) In addition, Applicants' amended independent claim 1 (and amended independent claims 7, 15, 23 and 33) recites "displaying available dispute handling forms having pre-defined content, said forms retrieved from said server, wherein said displayed forms comprises a pre-defined set of said available forms that are **available only to Issuers**, wherein the Issuer selects a particular one of the available forms utilizing said input means" (emphasis added) As previously discussed above, Rosen discloses an electronic merchandise system for use by customers and merchants that is not a system for facilitating communication during a post-transactional dispute between Issuers and Acquirers. In addition, Rosen fails to disclose, teach or suggest, *inter alia*, "displaying available dispute handling forms", "wherein said displayed forms comprises a pre-defined set of said available forms that are **available only to Issuers**". Instead, Rosen teaches the display of transactions logs and dispute information entered by the customer (see FIGS. 30A, col. 28, lines 50-55 and col. 29, lines 5-29).

**With respect to dependent claims 2-6, 9-14, 16, 19-22, 24-32 and 34-46**, as stated above, Applicants submit that all of the elements of the underlying independent claims 1, 7, 15, 23 and 33 are not present in the cited references either alone or in combination, and therefore are not present in claims 2-6, 9-14, 16, 19-22, 24-32 and 34-46. Accordingly, Applicants respectfully request the withdrawal of the Section 102 rejection with respect to claims 1-7, 9-17, and 19-46.

In addition, newly added claims 47-50 recite displaying a set of forms available only to Issuers wherein the displayed forms comprise "a retrieval request form, a first chargeback form, and a final chargeback form." Rosen fails to disclose or suggest "a retrieval request form, a first chargeback form, and a final chargeback form" as recited

by dependent claims 47-50. Therefore, newly added claims 47-50 are also not anticipated by Rosen.

**35 U.S.C. § 103**

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosen. Applicants respectfully traverse this rejection and provide the following arguments in support.

As noted above, all the claimed limitations of amended independent claim 7 (claim 8 is dependent on claim 7) are not taught or suggested by Rosen. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *MPEP 2143.03 citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).*

Accordingly, Rosen does not render claim 8 obvious. Applicants therefore respectfully request that the Examiner reconsider and withdraw this rejection to claim 8.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that all of the pending claims, namely 1-46, fully comply with 35 U.S.C §112 and are allowable over the art of record. Reconsideration of the application is respectfully requested. If the application is not allowed, Applicants respectfully request an Advisory Action from the Examiner. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to contact the undersigned at the Examiner's convenience.

Date: \_\_\_\_\_

6-Nov-2003

Respectfully submitted,

By: \_\_\_\_\_

David O. Caplan

David O. Caplan  
Reg. No. 41,655

**SNELL & WILMER, L.L.P.**  
One Arizona Center  
400 East Van Buren  
Phoenix, AZ 85004-2202  
Direct: (602) 382-6284  
Fax: (602) 382-6070  
Email: [dcaplan@swlaw.com](mailto:dcaplan@swlaw.com)